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10/706,051

11/13/2003

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08/02/2004

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EXAMINER

CHEN, BRET P

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,051

Applicant(s)

ISODA, YUJI

Examiner

B. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-3, 5-8 are pending in this application. Amended claims 1, 6 and canceled claim 4 are noted.

The amendment dated 6/30/04 has been entered and carefully considered. In view of the amendments to the claims, the 102 rejection has been withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron et al. (5,556,716). Herron teaches making a radio-conductive inorganic/organic composite film, including a BiI_3 /nylon composite, where the film can be formed by applying the film onto a substrate and heat pressing, where the heating is disclosed to be on the order of 50-150°C (col.4 line 24 - col.6 line 11; Examples 3-7). However, the reference does not teach the amount of pressure applied to the film during the heat pressing. However, one of ordinary skill in the art would have recognized that the amount of pressure applied during a heat pressing treatment is a cause effective variable, as the amount of pressure effects the compaction of the composite film. It is considered obvious to one having ordinary skill in the art to have determined the optimum value of a cause variable, such as pressure, through routine experimentation in the absence of a showing of a criticality in the claimed pressure. Therefore, it is the examiner's position that the claimed pressure would have been obvious to one skilled in

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the art practicing Herron with the expectation of providing the desired composite film formation, such pressure being determined through routine experimentation.

The limitations of claims 2-3 and 5-8 have been addressed above.

Response to Arguments

Applicant's arguments filed 6/30/04 have been fully considered but they are not persuasive.

Applicant first argues that Herron does not teach or suggest pressing the radio-conductive material in a state where the radio-conductive material is formed on a substrate (p.5).

The examiner disagrees. As mentioned previously, the reference clearly teaches of thermal pressing the film (col.6 lines 6-11). It is the examiner's position that the Herron precisely teaches of pressing the radio-conductive material onto a substrate.

Applicant next argues that the reference does not teach a lower pressure which does not break or deform the substrate (p.5).

The examiner agrees in part. The examiner has previously conceded that the reference remains silent on the specific pressure. However, it should be noted that the reference does not teach a broken or deformed substrate. As a result, it is the examiner's position that the claimed pressure range is inherently taught by Herron.

Applicant's arguments have been considered but are not deemed persuasive.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Chen whose telephone number is (571) 272-1417. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bc
7/30/04


BRET CHEN
PRIMARY EXAMINER